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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/518,048
Filing Date: March 02, 2000
Appellant(s): BARRITZ ET AL.

Max Moskowitz
Registration No. 30,756
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10 September 2007 appealing from the Office action mailed 6 March 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: Claims 34, 35, 37-41, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Franklin.

The appellant's statement of the remaining grounds of rejection under 35 U.S.C. 103(a) to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,867,714	TODD et al.	2-1999
6,049,799	MANGAT et al.	4-2000
6,105,069	FRANKLIN et al.	8-2000

Elmasri et al., "Fundamentals of Database Design," 1989, pp.544-545.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 34, 35, 37- 41, and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,105,069 to Franklin et al.

As per claim 34, and the Licensing Controller disclosed by Franklin, which constitutes a knowledge base facility, organizes databases into objects, such as for users, resources (such as computers or software application objects), and software licenses (see column 4, line 17 to column 5, line 50). The resources are organized into a database (see column 2, lines 29-33) that constitutes an inventory list. A linking between resource and license objects is also described (see column 10, lines 50-60).

Franklin also includes a query tool (see column 4, line 66 to column 5, line 21) for using the various databases that outputs query results.

Franklin further discloses that licensing objects may be implemented as API's (see column 2, lines 62-67; column 7, line 40 to column 8, line 8; and column 9, lines 4-20) and discloses a procedure that retrieves licensing information from the respective resources and a process by which necessary additional functionalities may be spawned by the applications (see figure 12 and column 14, line 12 to column 15, line 64).

Franklin does disclose embodiments wherein the product is used for database maintenance by an administrator rather than for the direct execution of a software product, including the display of linked data (see column 16, lines 12-23 and figures 11 and 12). Since the operation of the licensed software is not essential for this functionality, the negative limitations of Appellant's claims are anticipated.

Regarding claim 35, it is disclosed that the system may be run on a single system (see column 4, line 6) or a network of computers. Any package that can be run on a single system inherently can be used on a mainframe.

As per claims 37-39, a "numbers" attribute tracks installations, while the "metering" attribute may track actual usage (see column 11, lines 33-57).

As per claims 40 and 41, licensing attributes may include multiple contract terms, such as the charges (see column 6, lines 28-40).

Regarding claim 48, a properly keyed database is inherently capable of correlating 100% of related data.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al.

Franklin discloses that the invention may be used on a single computer such as a server, but does not specifically state that the computer be a mainframe.

Official notice is given that the use of mainframes as servers is well-known in the art, as mainframes are designed for serving large-scale environments.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to implement the invention of Franklin on a mainframe computer, as mainframes are designed for serving large-scale environments.

Claims 46, 47, 50, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 6,049,799 to Mangat et al.

Regarding claims 50 and 51, the "backlink" attribute disclosed by Franklin provides the means for the immediate updating of linking information when information in the corresponding tables are changed (see column 12, lines 13-27); however, no disclosure is given as to when the updating should actually take place.

Mangat discloses the updating of linking information upon the updating of the corresponding application (see column 11, lines 3-10), and suggests that this is to establish and re-make links (see column 2, lines 9-13).

Regarding claims 46 and 47, though Franklin discloses the use of different distinguished names to identify objects (see column 5, lines 22-30), a method for correlating objects based upon their distinguished names is not disclosed.

Mangat discloses the use of fuzzy logic to associate different documents with similar distinguished names (see abstract).

Mangat further suggests that this all is to establish and re-make links (see column 2, lines 9-13).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating of linking information upon the updating of the corresponding applications, and by using fuzzy logic to associate databases by their distinguished names, as disclosed by Mangat, in order to establish and re-make links.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of U.S. Patent No. 5,867,714 to Todd et al.

Though Franklin discloses a means for incorporating new software product data into the database, the way in which software products are acquired is not disclosed (see column 15, lines 3-17).

The software distribution system disclosed by Todd distributes software from a remote server to computers (see abstract), and suggests that this allows for the remedying of faults before they actually become faults (see column 3, lines 1-8).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by distributing software from a remote server to computers on a periodic basis, as disclosed by Todd, in order to remedy problems before they actually become faults.

Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,105,069 to Franklin et al. as applied to claim 34 above, and further in view of Elmasri et al., "Fundamentals of Database Design," 1989, pp. 544-545.

Franklin does not disclose the updating of databases on a periodic basis.

Elmasri discloses the updating (committing) of databases periodically at checkpoints, and suggests that this aids recovery in the event of a system crash.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Franklin by updating the databases using checkpoints, in order to aid recovery in the event of a system crash.

(10) Response to Argument

Regarding claim 34, Appellant's argues that an executable that is not the API as disclosed by Franklin interfaces with the software facilities. Franklin includes an embodiment in which an API "performs all ... (use) of the licensing attributes." See column 15, lines 7-14. Therefore, the API is the executable that is disclosed by Franklin in that embodiment, and all other corresponding limitations are anticipated as described above. Applicant's assertion that the software product does not include an API is based upon alternate embodiments that are not limiting, such as the NetWare implementation. See column 15, line 10.

Regarding Appellant's argument that Franklin does not anticipate the claimed invention because it includes spawned applications, such spawned applications are

nonetheless part of Franklin's system, and are activated as needed by other programs. They therefore cannot be discounted from Franklin's disclosure in determining the patentability of Appellant's claimed invention.

Regarding Appellant's argument that Franklin does not teach to a system that "is not operable to affect operation of any software product," in the examination of a patent application, the meanings of claim terms are given their broadest reasonable interpretation in light of Appellant's specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000), *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-17 (Fed. Cir. 2005) (en banc).

Given that the claimed invention requires the use of an API in the software products (as per the first two limitations and Specification, p. 12, lines 23-26), which is executable code, one would not reasonably ascertain that the claimed invention does not allow for the software products to be devoid of any execution, since the invention would not be able to function; rather, a reasonable interpretation of the claim would be that in being "not operable to affect operation," the software product is executed at least to the extent that the API is effected, without interfering with the software product's other functionality. There is no reason to believe that Franklin does not do this; claim 34 is therefore anticipated and all of the remaining claims are further unpatentable for the reasons stated above. The rejection is therefore proper.

Regarding claims 35-43 and 46-51, Appellant argues that the claims are patentable for the same reasons as claim 34; therefore, the rejections of these claims are proper.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Matthew Heneghan

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SUPERVISORY PATENT EXAMINER

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